

REMARKS

This responds to the Office Action mailed on February 9, 2006.

No claims are amended, added, or cancelled. Claims 3-14 remain pending in this application.

§103 Rejection of the Claims

Claims 3 and 7-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216).

Applicant traverses the rejection since, even if combined, the cited references fail to teach or suggest all of the elements of Applicant's claimed invention. Claim 3 recites: providing a blank photo-grade sheet; attaching a mounting strip along an edge of the blank photo-grade sheet; sending the blank photo-grade sheet and attached mounting strip through a printer to print a photographic image on the photo-grade sheet; and mounting the printed sheet in an album using the mounting strip.

In contrast, neither cited reference includes a blank photo-grade sheet. Hunter discusses index dividers and Policht discusses mounting pre-developed photographic prints to a binder. Accordingly, even if combined, the combination does not include a blank photo-grade sheet or sending the blank photo-grade sheet and its attached mounting strip through a printer.

In the Office Action, the Examiner states that "[w]ith respect to the requirement for *photo-grade paper*, the applicant should note that insofar as structure is defined, the printer paper sheet 110 of Hunter meets this limitation, as a photo of good quality may be printed on the sheet." Applicant traverses this characterization of the Hunter reference. In the previous response, Applicant submitted a Declaration of Paul Mott. Mr. Mott, as an expert in the field, asserted that the Hunter reference does not teach "photo-grade paper" as that term is understood in the field of the present invention. In the present Office Action, the Examiner states that the affidavit was not persuasive since the affidavit did not "outline the characteristics of the Hunter paper that disqualifies it from being defined as 'photo-grade'." (Page 7 of Office Action).

Applicant herewith provides a second affidavit from Mr. Mott. In this affidavit, Mr. Mott makes it clear that the definition of photo-grade paper is well established in the paper industry. The attached Standard ISO 18055-1 defines photo-grade medium as a paper or film with an image receiving layer that, when printed on, can produce image quality comparable with conventional photography, in terms of resolution, graininess, sharpness, tone reproduction and colour reproduction. The standard also states that a photo-grade medium has physical characteristics comparable with conventional photographic media including stiffness, mass, texture and durability, and is generally intended for inkjet printing of photographic images in high quality and demanding applications. (Section 4.1)

Mr. Mott establishes that the standard confirms the meaning of photo-grade paper as used in the industry. Mr. Mott further establishes that the Hunter papers have neither the physical characteristics nor the image quality to meet the standard. These papers would allow inkjet ink to absorb quickly and non-uniformly, creating a very grainy and uneven image when printed, while true photo grade papers do not allow this to happen.

Accordingly, the paper described in the Hunter reference does not fit the definition of “photo-grade paper,” since it has none of the criteria of photo-grade paper as the term is understood in the industry and defined by standard ISO 18055-1. Thus, given its proper evidentiary weight, Mr. Mott’s Declaration and the attached standard overcome the unsupported assertion of the Examiner that “a photo of good quality may be printed on the sheet [of Hunter].”

Moreover, as noted before, the Hunter reference teaches away from Applicant’s claimed invention. A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).

Here, Hunter describes index divider sheets that are used for three-ring notebooks. One skilled in the art would not be motivated to substitute photo-grade paper for such divider sheets. Photo-grade paper would not work well as divider sheets, which require a heavy, stiff paper, such as cardstock. (Hunter, col. 6, lines 61-62). Accordingly, one skilled in the art, upon reading the Hunter reference would be led in a direction divergent from the subject matter recited in the

claims since substituting photo-grade sheets for the cardstock of the Hunter index dividers is not a logically motivated substitution.

Claims 7-9 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claims 10-12

Claim 10 also includes the limitation of a “photo-grade sheet” and the above argument is incorporated herein by reference. Claim 11-12 depend from claim 10. Reconsideration and allowance is respectfully requested.

Claims 4, 6, 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216) as applied to claims 3 and 7-12 above, and further in view of Tyler (US 4,207,366).

Claims 4, 6, and 13-14 include each limitation of their parent claims and are not obvious for the reasons given above. Moreover, Applicant traverses the present rejection. Applicant believes claims 4, 6 and 13-14 are not obvious in view of the present references since there is no suggestion to combine the references as suggested.

As noted, Hunter teaches an index divider. The secondary reference, Tyler, discusses an art paper used for watercolors. This teaches away from being used in a printer. Moreover, any combination of the Tyler paper substituted for the Hunter cardstock would not work well as an index divider since these are different papers for completely different uses.

Moreover, regarding claim 14, Applicant does not believe that the merely noting that Tyler teaches acid free paper is enough to find a motivation for one to provide an acid free hinge. One does not necessary lead to the other without a motivation in the art. Reconsideration and allowance is respectfully requested.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216) as applied to claims 3 and 7-12 above, and further in view of Singh et al. (US 6,332,953).

Claim 5 includes each limitation of its parent claim and is not obvious for the reasons given above. Moreover, Applicant traverses the present rejection. Applicant believes claim 5 is not obvious in view of the present references since there is no suggestion to combine the references as suggested. As noted, Hunter teaches a cardstock index divider. The secondary reference, Singh, discusses an envelope paper. A combination of the Singh paper would not work well as an index divider and thus the references teach away from being combined. Reconsideration and allowance is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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This paper or fee is being filed on the date indicated above using the USPTO's electronic filing system EFS-Web, and is addressed to: The Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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